



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,482	03/30/2004	Paula Olhoft	600.479US2	4796
21186	7590	10/30/2006	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402			HELMER, GEORGIA L	
			ART UNIT	PAPER NUMBER
			1638	

DATE MAILED: 10/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

14

Office Action Summary	Application No. 10/813,482	Applicant(s) OLHOFT ET AL.	
	Examiner Georgia Helmer	Art Unit 1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 57-75 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 57-75 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

1. Claims 59 and 60 are indicated as being dependent on claims 37 or 62.

However no claim 37 exists in the instant case. The Office assumes that this is an error and assumes that claims 59 and 60 depend on claims 57 or 62. The Applicant needs to clarify the claims and dependencies in their next response.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 57-60 and 63-75, drawn to a stable transformation method comprising monocot plant tissue or cells and Agrobacterium, classified in class 800, subclass 294.
- II. Claim 62, 58-60 and 63-75 drawn to stable transformation method comprising plant tissue or cells and Agrobacterium, classified in class 800 subclass 294.

Art Unit: 1638

3. However, Group I or II claims are hereby restricted to agents from the group (a) – (e) as listed below. Applicant needs to elect one of these agents from the groups (a) – (e) for further prosecution.

4. Agents.

- (a) A sulfhydryl-containing agent.
- (b) Methionine.
- (c) An iron chelator.
- (d) A copper chelator.
- (e) An inhibitor of plant polyphenol oxidase.
- (f) And inhibitor of plant peroxidase.

5. Furthermore, Group I or II inventions are hereby also restricted to plants from the group (i.) – (iv.) as listed below. Applicant needs to elect one of the plants from the groups (i) –(iv) for further prosecution.

6. Plants.

- (i) Maize (class 800, subclass 320.1).
- (ii) Wheat (class 800, subclass 320.3).
- (iii) Sugarcane (class 800, subclass 320).
- (iv) Rice (class 800, subclass 320.2).

To clarify, Applicant needs to choose one of Group I or II inventions. Then Applicant also needs to choose one of group (a) – (f) agents, AND one of group (i) – (iv) plants.

7. Groups I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case they have different modes of operation, different functions, or different effects. The methods have different starting materials.

8. Inventions (a) – (f) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case they have different modes of operation, different functions, or different effects. The agents of the different inventions have different effects, as is evidenced by their grouping as sulfhydryl-containing agent, methionine, an iron chelator, a copper chelator, an inhibitor of plant polyphenol oxidase, and inhibitor of plant peroxidase. Their effects are different and that is precisely why they are being used in the current inventions.

9. Inventions (i) – (iv) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case they have different modes of operation, different functions, or different effects. The plants of the different inventions are each totally distinct from the other and each has its own class and subclass, as indicated.

Art Unit: 1638

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

11. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

12. The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

13. Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Remarks

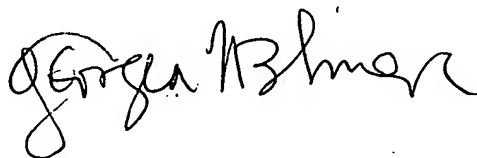
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Georgia Helmer whose telephone number is 571-272-

Art Unit: 1638

0796. The examiner can normally be reached on 10-6 Monday through Thursday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on 571-272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Georgia Helmer PhD
Patent Examiner
Transgenic Plants -au 1638
2 October 2006

A handwritten signature in black ink, appearing to read "Georgia Helmer", is written over the typed name.